

REMARKS

This Amendment, submitted in response to the Office Action dated January 29, 2004, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Turning to preliminary matters first, claims 7, 15, 16, 18, 19 and 22-25 have been objected to for informalities. Applicant submits that amendment of the claims is not necessitated by 35 U.S.C. § 112. However, in order to expedite prosecution of the present application, claims 7 and 22-25 have been amended as indicated above.

Claims 6, 7 and 14-25 are pending in the present application. Claims 14-20 have been canceled from the present application.

Claims 17-20 have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 14-20 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Stern et al (USP 5,631,734). Claims 6, 7, 21, 22 and 25 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Stimpson (USP 6,037,186) as evidenced by Hayes et al (USP 4,877,745). Claims 23 and 24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Stimpson and Shuminov (USP 5, 808,554). Applicant submits the following in traversal of the rejections.

Rejection of claims 17-20 under § 112, second paragraph as being indefinite

Claims 17-20 have been canceled. Therefore, the rejection of claims 17-20 under § 112, second paragraph is moot.

Rejection of claims 14-20 under § 102(e) as being anticipated by Stern

Claims 14-20 have been canceled. Therefore, the rejection of claims 14-20 under §102(e) as being anticipated by Stern is moot.

***Rejection of claims 6, 7, 21, 22 and 25 under § 102(e)
as being anticipated by Stimpson and Hayes***

Claim 6

The Examiner cites Stimpson for teaching the plurality of applicators, conveyor and cutting means of claim 6.

The Examiner contends that Stimpson provides a cutting means. However, the mere fact that the roll becomes cut does not mean the apparatus includes the cutting means as claimed. For example, cutting performed by an operator may provide a cut. Under the holding of *In re Bell*, 26 USPQ2d 1529, (Fed. Cir. 1993), such does not meet all the requirements of an apparatus claim.

To the extent Stimpson and Hayes includes an XYZ table and applicator, the apparatus does not provide an apparatus for providing a strip like substrate. Fig. 1C of the Stimpson reference clearly show a disk array, rather than a strip.

Furthermore, as previously indicated, functional limitations should be given consideration. There is nothing inherently wrong with defining some part of the invention in functional terms. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what is fairly conveyed to a person of ordinary skill in the pertinent art in the context in which it is used. MPEP 2173.05.

The Examiner has not established that the functional limitations of claim 6 are taught in the prior art. In particular, Stimpson does not teach the functional aspects of the claims as

indicated by the Examiner. See page 9 of the Office Action. Therefore, claim 6 and its dependent claims should be deemed patentable.

***Rejection of claims 23 and 24 under § 103(a) as being
unpatentable over Stimpson and Shuminov***

As a preliminary matter, Shuminov is nonanalogous art. To rely on a reference under 35 U.S.C. § 103, it must be analogous art. A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. *Wang Laboratories Inc. v. Toshiba Corp.*, 26 USPQ2d 1767 (Fed. Cir. 1993).

Shuminov pertains to the detection of moisture in a diaper by placing an electrode in the liner of the diaper. See Abstract. Therefore, it is unlikely that an inventor would look to a process for creating a diaper for teaching the apparatus for a strip-like substrate containing binding agents, as described in the present invention. Further, Shuminov including various compaction and assembly for a diaper would not be reasonably pertinent to the precision required in substrate assembly. Therefore, Shuminov may not be combined with Stimpson to teach elements of claims 23 and 24.

Furthermore, the Examiner's rejection of claims 23 and 24 is deficient for the same reasons indicated above. In particular, the Examiner has not established that the functional aspects of the claims are taught in the prior art. Therefore, claims 23 and 24 should be deemed patentable.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO.: 09/373,585

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The cited cutter of the diaper-making device is inapplicable to the field of invention as previously indicated in the Brief on Appeal, cutting devices in one field are not applicable across all fields. *A.J. Dees Co. v. U.S. Slicing Mach. Co.* 21 F.2d 812, 813 (7th Cir. 1927).

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

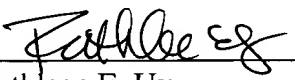
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